

REMARKS

The present Amendment amends claims 1-31. Therefore, the present application has pending claims 1-31.

Applicants note that the Examiner has not considered the Information Disclosure Statement submitted on August 30, 2001 in the United States Patent and Trademark Office along with the present application. A copy of said August 30, 2001 Information Disclosure Statement is attached. The Examiner is requested to consider the August 30, 2001 Information Disclosure Statement and provide an indication of such consideration in the forth coming Office Action.

Claims 15 and 22 stand objected to due to informalities noted by the Examiner in paragraphs 2 and 3 of the Office Action. Amendments were made to claims 15 and 22 to correct the informalities noted by the Examiner. Therefore, Applicants submit that this objection is overcome and should be withdrawn.

Claims 1-31 stand rejected under 35 USC §103(a) as being obvious over Horstmann (U.S. Patent No. 6,285,985). This rejection is traversed for the following reasons. Applicants submit that the features of the present invention as now more clearly recited in claims 1-31 are not taught or suggested by Horstmann whether taken individually or in combination with any of the other references of record. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Amendments were made to each of the independent claims 1, 15, 16 and 26 in order to more clearly describe features of the present invention not taught or suggested by any of the references of record particularly Horstmann whether taken individually or in combination with each other.

Specifically, amendments were made to the claims so as to more clearly recite that the present invention is directed to a method for providing advertisement information, an advertising information supply system and a broadcast receiver terminal for receiving and outputting the advertisement information.

According to the present invention, advertisement information provided by a commercial sponsor is stored into an advertisement storage means and the advertisement information is read from the advertisement storage means from time to time. The advertisement information read out from the advertisement storage means is sent via an information transmission line to a broadcast receiver terminal. The broadcast receiver terminal upon receipt of the advertisement information sends viewing history information which was stored in the broadcasting receiving terminal to the sender of the advertisement information. The viewing history information represents a history of playing the advertisement information by the broadcast receiver terminal. The viewing history information is used to calculate a charge for providing the advertisement information and the charge is to be paid by the commercial sponsor.

The above described features of the present invention now more clearly recited in the claims are not taught or suggested by Horstmann

whether taken individually or in combination with any of the other references of record.

Horstmann teaches a mechanism allowing a software developer to present advertisement through a software program. Particularly, Horstmann is directed to electronic advertising particularly the use of "banner ads".

In Horstmann, an advertisement module is attached to the software program. The function of the advertisement module is to retrieve advertisements from an advertisement server and to display the advertisements to the user. Further, Horstmann teaches that the information about the user may be sent to the advertisement server allowing advertisements to be targeted to the user. Such information as taught by Horstmann can include the category of the software program and the user usage of the software program.

However, Horstmann does not anticipate nor render obvious the features of the present invention as now more clearly recited in the claims. Particularly, Horstmann does not anticipate nor render obvious the features of the present invention as recited in the claims regarding the step of receiving from a broadcasting receiver terminal information of a viewing history indicating the history of playing the advertisement information by the broadcasting receiving terminal. Further, there is no teaching or suggestion in Horstmann of the features of the present invention as recited in the claims that the viewing information is used to calculate a charge for providing the advertisement information and that such calculated charge is to be paid by the commercial sponsor of the advertisement information.

In the Office Action the Examiner sets forth numerous allegations that various teachings in the claims are “implicit” in Horstmann. In these instances, the Examiner readily admits that “Horstmann lacks an explicit recitation” of various features of the present invention recited in the claims including “history information”, “some elements of claims 2-14”, “some elements of claims 17-25”, “broadcast by radio-wave via satellite or terrestrial wave”, and “some elements of claims 27-31”.

To account for the numerous deficiencies in Horstmann relative to the features of the present invention as recited in the claims, the Examiner takes “Official Notice” of alleged “notoriously well known and expected” teachings in the art. Applicants hereby traverse each of the Official Notices taken by the Examiner in the Office Action and specifically request that the Examiner supply a reference to support each of the Official Notices. In the Office Action, it is noted that the Examiner states that such teachings may be implicit in Horstmann but does not point to any specific teaching thereof of the elements recited in the claims to which the Examiner is taken Official Notice. The Examiner’s attention is directed to the procedure for alleging Official Notice in MPEP 2144.03. In this section, it specifically states that if Applicants challenge an Official Notice, then the Examiner must support the allegation of Official Notice with adequate evidence particularly another reference which has specific teachings regarding the matter to which Official Notice is taken. In the Office Action the Examiner simply states that Horstmann “implicitly” discloses the elements to which Official Notice is taken. These alleged

“implicit” teachings are not sufficient evidence in accordance with MPEP 2144.03.

Therefore, based on the above, Applicants submit that the Examiner has not made a prima facie case of obviousness relative to the features of the present invention as recited in the claims based on Horstmann.

Accordingly, based on the above, Applicants submit that Horstmann fails to teach or suggest sending the advertisement information read out from the advertisement storage means via an information transmission line and receiving, via the information transmission line or a different information transmission line, information on a viewing history stored in the broadcasting receiver terminal, said viewing history information representing a history of playing said advertisement information by said broadcasting receiver terminal as recited in the claims.

Further, Horstmann fails to teach or suggest using the viewing history information to calculate a charge for providing the advertisement information to be paid by the commercial sponsor as recited in the claims.

Therefore, based on the above, it is quite clear that the features of the present invention as now more clearly recited in the claims are not taught or suggested by Horstmann whether taken individually or in combination with any of the other references of record. Accordingly, reconsideration and withdrawal of the 35 USC §103(a) rejection of claims 1-31 as being obvious over Horstmann is respectfully requested.


The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the reference utilized in the rejection of claims 1-31.

In view of the foregoing amendments and remarks, applicants submit that claims 1-31 are in condition for allowance. Accordingly, early allowance of claims 1-31 is respectfully requested.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C., Deposit Account No. 50-1417 (503.40569X00).

Respectfully submitted,

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